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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,566	11/09/2001	Thomas Becker	9777000-0022	2249

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/039,566

Applicant(s)

BECKER, THOMAS

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-82 and 84-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-82 and 84-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Request for Continued Examination***

1. The request filed on December 9, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/039,566 is acceptable and an RCE has been established. An action on the RCE follows.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 87 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the limitation of the synthetic panel being formed of a material without molding could not be located in the specification. As seen on page 5 of the specification, the synthetic panel is made of material produced by synthesis, and not of natural origin. This passage fails to disclose the panel being made without molding.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 18, 20, 22-25, 29, 30, 32-36, 41, 45-47, 51, 52, 54-58, 65-67, 71, 75, 76, 78-82 and 84-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez ('283).

Pelaez discloses an advertisement device (10) for direct mail delivery to a recipient comprising a synthetic panel (see col. 1, lines 59-64), having a back side (as seen in figures 4 and 5), a front side (as seen in figure 1) having decorative or humorous material (11), at least one of the back side and the front side having indelible printing, inherently, comprised of an indelible ink formulated for printing on synthetic materials (see col. 1, lines 16-26, 64-68 through col. 2, lines 1-11 and col. 2, lines 36-40) and having a thickness sufficient to maintain integrity of the synthetic panel (as seen in figure 3).

Regarding claim 2, Pelaez discloses the claimed invention except for the specific arrangement and/or content of indicia (delivery information directly on the front or back side of the synthetic panel) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the advertisement device, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that

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when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of advertisement device does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Note: the printing method used to apply the information to the panel, does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113) Furthermore, any of these conventional printing methods could be used to provide the information on the panel of Pelaez.

Regarding claim 3, Pelaez discloses the information being preprinted on a separate label (21 – printed paper backing) and applied to a surface of the back side of the synthetic panel (see col. 2, lines 41-53).

Regarding claim 4, Pelaez discloses the synthetic panel comprising humorous or decorative material which would, inherently, include a theme related to a product or a service.

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Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired synthetic material for the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 20, Pelaez discloses the post card being made of an injection molded synthetic plastic material (see col. 1, lines 59-64 of Pelaez).

Regarding claims 22-25, Pelaez discloses means (15 – adhesive strip assembly in the form of a pressure-sensitive adhesive material 18 covered by a protective cover strip 19) to attach the device to a surface (see col. 2, lines 20-35 of Pelaez).

Regarding claims 29, 30 and 32, Pelaez discloses a mechanism (15) to carry another item (see col. 2, lines 20-35 of Pelaez – “...or other smooth surface...”). The item, inherently, could include one of a coupon, a business card, a credit card and a refrigerator magnet since these items have at least one smooth surface.

Regarding claims 33-36, 41, 45-47, 51, 52 and 54, the method of delivering an advertisement device by direct mail delivery to a recipient is inherently disclosed in the above rejections.

Regarding claims 55 and 56, Pelaez discloses the advertisement device system as set forth above. Pelaez further discloses means for applying the delivery information (“such as by running an inking roller over the face of the card...” – see col. 1, lines 67-68 through col. 2, lines 1-3 and col. 2, lines 36-40 of Pelaez).

Regarding claims 57, 58, 65-67, 71, 75, 76 and 78, see the above rejections.

Regarding claim 79, Pelaez discloses the advertisement device for direct mail delivery to a recipient as set forth in the above rejections. Regarding the shape of the panel, it would have been an obvious matter of design choice to make the different portions of the panel of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Regarding claims 80-82, Pelaez discloses the synthetic panel having a non-porous surface adapted for receiving printing inks and the synthetic panel being made of a memory shape-retaining material (see col. 1, lines 3-8 and 59-68 through col. 2, lines 1-8 of Pelaez).

Regarding claims 84 and 85, Pelaez discloses the claimed advertisement device as set forth in the above rejections.

Regarding claims 86-89, the method of delivering an advertisement device by direct mail delivery to a recipient is inherently disclosed in the above rejections.

6. Claims 5-13, 26-28, 38-40, 48-50, 59, 61-64 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Buchler ('823).

Pelaez discloses the claimed invention except for the synthetic panel having an embedded cutout cut (by either die cutting, knife cutting) from a synthetic sheet.

Buchler discloses a plurality of non-rectangular letter cards (402, 502, 602) having holes (402b, 502b) for suspension of the cards on a nail, hook or the like (see col. 9, lines 63-68 through col. 10, lines 1-3). The outline of the cards can resemble a

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flower, a bell, a flag, a church, etc., "so that the appearance of the card is suggestive of its purpose (e.g., condolence or birthday celebration)." (see col. 10, lines 3-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include non-rectangular card having a cutout, as taught by Buchler, to display the cards in a retail store, at home on the wall, or similar places.

Note: The use of grommets in holes is conventional in the art and it would have been obvious to one having ordinary skill in the art to provide a grommet in the hole of Pelaez, as modified by Buchler.

Regarding claims 6-8, the method of forming the cut out (i.e., die cut, knife cut, implemented when molded) does not structurally limit the claim.

Regarding claim 11, Pelaez, as modified by Buchler, discloses using various colors for printing an image on the panel (see col. 2, lines 3-11 of Pelaez). Furthermore, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. *In re Seid*, 73 USPQ 431.

Regarding claim 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the same printed pattern on the front and back sides of the synthetic panel, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.



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7. Claims 14-17, 19, 21, 37, 42-44 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Aamodt et al. ('969).

Pelaez discloses the claimed invention except for the device having an anti-microbial agent.

Aamodt et al. disclose a paper material that can be impregnated with at least one chemical material. In one embodiment of Aamodt et al. the paper is impregnated with a gaseous peracetic acid that diffuses out of pores in the paper, creating a no-growth zone on the surface of the paper (see col. 1, lines 10-17, 28-35 and 51-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include an anti-microbial agent on the panel, as taught by Aamodt et al., to provide a "paper product which can inhibit the growth of microorganisms..." (see col. 1, lines 47-49).

8. Claims 31, 53 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Huff et al. ('654).

Pelaez discloses the claimed invention except for the mechanism to carry another item comprising a shrink wrap to hold the item to the device.

Huff et al. disclose a postcard (100) for carrying a disk medium comprising a front side (1114) having a first area (116) and a second area (118). In a preferred embodiment, a label is attached to the back side of the postcard and the means for attaching the disk medium may be located on the back side of the postcard. The second area includes a pocket (120) attached to the postcard. The pocket is formed from a

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sheet (126) of thin flexible transparent plastic material. A thin transparent, film of plastic (130) is snugly attached to the postcard by a shrink wrap process. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include a pocket shrink-wrapped to the card, as taught by Huff et al., to provide a means for securely carrying additional items in combination with the postcard for delivery to a recipient.

9. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Buchler and further in view of Aamodt et al.

Pelaez, as modified by Buchler, discloses the claimed invention except for the device having an anti-microbial agent.

Aamodt et al. disclose a paper material that can be impregnated with at least one chemical material. In one embodiment of Aamodt et al. the paper is impregnated with a gaseous peracetic acid that diffuses out of pores in the paper, creating a no-growth zone on the surface of the paper (see col. 1, lines 10-17, 28-35 and 51-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include an anti-microbial agent on the panel, as taught by Aamodt et al., to provide a "paper product which can inhibit the growth of microorganisms..." (see col. 1, lines 47-49).

***Response to Arguments***

10. Applicant's arguments filed December 9, 2003 have been fully considered but they are not persuasive.

Claims 1-4, 18, 20, 22-25, 29, 30, 32-36, 41, 45-47, 51, 52, 54-58, 65-67, 71, 75, 76 and 78-90

Applicant argues that Pelaez fails to disclose an indelible ink formulated for printing on synthetic materials printed thereon. The examiner disagrees and maintains that the decorative or humorous material molded in bold relief and inked by running an inking roller over the face of the card comprises indelible ink since one purpose of the card is to be mounted or "attached against a flat surface for permanent use as a decorative or humorous plaque or picture." (emphasis on "permanent" - see col. 1, lines 16-26). Clearly, to enable the card to be a permanent display device, the printing on the card would be such that the printing would not degrade over time.

Applicant argues that Pelaez fails to disclose printing delivery information on one of the front and back sides of the panel using at least one of silk screening, sheet fed printing, web offset printing, web letter press printing, gravure printing and ink jet printing. The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the advertisement device, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, the printing method used to apply the information to the panel does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are

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not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113) Furthermore, any of these conventional printing methods could be used to provide the information on the panel of Pelaez.

Applicant argues that Pelaez fails to disclose the synthetic panel having a shape related to a theme of one of a product and a service being advertised by the device. The examiner maintains that the shape of the panel could be of whatever form or shape as desired by the user depending on the message to be conveyed.

Applicant argues that Pelaez fails to disclose forming a synthetic panel of a material without molding. The examiner maintains that support for this limitation could not be found in the specification as set forth in paragraph 3 above.

Claims 5-13, 26-28, 38-40, 48-50, 59, 61-64 and 72-74

Applicant argues that Pelaez, as modified by Buchler, fails to disclose the claimed invention except for synthetic panel having at least one of a printed pattern related to a theme of at least one of a product and a service, and a cutout embedded in the synthetic panel related to a theme of at least one of a product and a service. The examiner disagrees and maintains that Pelaez disclose the panel having decorative or humorous material printed thereon; inherently, this would include a product or service. However, Pelaez fails to disclose a cutout in the panel. Buchler discloses non-rectangular letter cards having holes 402b, 502b embedded in the cards. The cutout follows the outline circular cutout as seen in figures 7 and 8. Regarding the cutout relating to a theme of a product or a service, the circular cutout is capable of relating to

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a product such as an endless ring, a circular disk, etc. It is noted that Buchler has not been relied upon for disclosing any of the other claimed limitations.

Claims 14-17, 19, 21, 37, 42-44 and 68-70

Applicant argues sets forth the substantially the same arguments as set forth above. The examiner, therefore, maintains the same line of reasoning as previously set forth above.

Applicant further argues that none of the cited references disclose ink comprising an anti-microbial agent and a coating comprising an anti-microbial agent on at least one surface of the synthetic panel. The examiner disagrees and maintains that Pelaez, as modified by Aamodt et al. disclose a panel being impregnated with at least one chemical material.

Claims 31, 53 and 77

Applicant argues sets forth the substantially the same arguments as set forth above. The examiner, therefore, maintains the same line of reasoning as previously set forth above.

It is noted that Huff et al. is used solely for disclosing a postcard including a thin transparent film of plastic attached to the postcard by a shrink wrap process and has not been relied upon for disclosing any of the other claimed limitations.

Claim 60

Applicant argues sets forth the substantially the same arguments as set forth above. The examiner, therefore, maintains the same line of reasoning as previously set forth above.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

January 8, 2004

*Monica S. Carter*  
**MONICA S. CARTER**  
**PRIMARY EXAMINEE**